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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,593	06/29/2001	David C. Ashby	A-23	9718

7590 07/21/2004
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EXAMINER

ELISCA, PIERRE E

ART UNIT PAPER NUMBER

3621

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/897,593

Applicant(s)

ASHBY, DAVID C.

Examiner

Pierre E. Elisca

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WU

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/26/2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office action is in response to Applicant's Response, filed on 4/26/2004.
2. Claims 1-25 are pending.
3. The rejection to claims 1-12 under 35 U.S.C. 103 (a) as being unpatentable over Whitmyer in view of Brown and to claims 13-25 under 35 U.S.C. 103 (a) as being unpatentable over Whitmyer and Brown in view of Biffar as set forth in the Office action mailed on 1/22/2004 is maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitmyer (U.S. Pat. No. 5,895,468) in view of Brown (U.S. pat. No. 6,571,141).

As per claims 1, 3-4, 6, and 8-12 Whitmyer substantially discloses a device for automatically delivering professional services to a client. The device includes a

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computer and a database containing a plurality of client reminders. The device also includes software executing on the computer for automatically querying the database by date to retrieve a client reminder, for automatically generating a client response (which equivalent to Applicant's claimed invention wherein it is stated that a docket management comprising:

a control structure including a processor configured to execute a control program and communicate with a user (see., abstract, col 5, lines 38-56, specifically software executing on the client computer receives the merged client email...);

A memory coupled to the processor and configured to store a plurality of records associated with a project, and a plurality of records storing attributes including access levels associated with a plurality of users (see., abstract, figs 1, and 2, item 14, col 3, lines 16-45);

an authorization structure coupled to the processor and configured to selectively allow the users to log into the control structure and access the records to selectively add, modify and read project records depending on the users' access levels (see., abstract, col 3, lines 46-67, specifically wherein it is stated that the individual professional responsible for the client, generating a transfer of funds authorization and transferring the authorization to a bank., fig 1, item 14/update, it is inherent to recognize that the item 14/update can add, edit modify and delete users respective attributes);

A communication structure coupled to the processor including a notification structure configured to periodically distribute information to project personnel based on predefined criteria including dates or activities (see., col 5, lines 38-56, and the

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processed of predefined criteria including dates see., col 1, lines 5-6, specifically wherein it is stated that replies for client due dates). It is to be noted that Whitmyer fails to explicitly disclose Applicant's newly added limitation wherein said the authorization structure including administrative access control that allows selectively granting access levels to project personnel. However, Brown discloses a security system 110 that compares the username and password with an internal database, set or list to determine the user's level of access. If the user is not a program administrator, the user has access to the motion control component (see., abstract, col 6, lines 41-56, col 9, lines 30-37). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the automating delivery of Whitmyer by including the limitation detailed above as taught by Brown because this would limit access to certain project records.

As per claim 2, Whitmyer discloses the claimed limitations of authorizing structure provides the ability for a user with an administrative access level to add, edit, modify and delete users and their respective attributes including access levels (see., col 5, lines 38-56, fig 1, item 14/update, it is inherent to recognize that the item 14/update can add, edit modify and delete users respective attributes).

As per claims 5, and 7 Whitmyer discloses the claimed limitations wherein the memory is configured to store documents along with attributes including a date stamp or due dates; and the communication structure is configured to electronically publish a

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document on the internet and display the date stamp attribute associated therewith (see., col 1, lines 5-6, fig 1, item 14).

6. Claims 13-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitmyer (U.S. Pat. No. 5,895,468) in view of Brown (U.S. pat. No. 6,571,141), and further in view of Biffar (U.S. Pat. No. 6,205,435).

As per claims 13-25, Whitmyer and Brown disclose the claimed limitations as stated in claim 1 above. It is to be noted that Whitmyer and Brown fail to disclose an escrow structure and payment plan. However, Biffar discloses a self-contained payment that includes an escrow account 30 and a payment option or plan (see., col 2, lines 16-21, col 3, lines 49-67). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Whitmyer and Brown by including the limitation detailed above as taught by Biffar because this would limit access to certain project records.

RESPONSE TO ARGUMENTS

7. Applicant's arguments filed on 4/26/2004 have been fully considered but they are not persuasive.

REMARKS

8 a. Applicant maintains that Whitmyer, Brown and Biffar cannot be combined, the Examiner recognizes that obviousness can only be established by combining or

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modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In *re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter); and *Es parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to *Ex parte Levengood*, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound

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scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

b. In response to claims 1-5, and 11-12, Applicant argues that the prior art of record do not disclose: " an authorization structure coupled to the processor and configured to selectively allow the users to log into the control structure and access the records to selectively add, modify and read project records depending on the users' access levels". Based upon the foregoing rejection indicated above, it is believed that the Whitmyer's reference discloses this limitation (see., abstract, col 3, lines 46-67, specifically wherein it is stated that the individual professional responsible for the client, generating a transfer of funds authorization and transferring the authorization to a bank., fig 1, item 14/update. It is inherent to recognize that the item 14/update can add, modify and read users respective attributes. Please note that when updating an item the user (s) is capable of modifying, adding and read users respective attributes).

c. In response to claims 6-10, Applicant argues that the prior art of record fail to disclose: " wherein the communication structure includes an electronic filing structure configured to electronically file a document with another computer system; and wherein the memory is configured to store attributes of the document including a date stamp". As noted in the Office action mailed on 09/03/2003, it is also believed that the Whitmyer's reference discloses this limitation see., col 1, lines 5-6, fig 1, item 14, specifically wherein said an automated system for preparing reminders and soliciting replies for client due dates or (due dates or date stamp).

d. Applicant also contends that Biffar does not disclose an escrow structure. However, the Examiner respectfully disagrees since Biffar discloses a self-contained payment that includes an escrow account 30 and a payment option or plan (see., col 2, lines 16-21, col 3, lines 49-67).

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

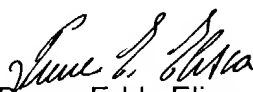
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent Examiner

July 19, 2004